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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,121	05/16/2003	Karin Klokkers	4271-34PUS	8059

7590 07/23/2009

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EXAMINER	
GHALI, ISIS A D	
ART UNIT	PAPER NUMBER
1611	

MAIL DATE	DELIVERY MODE
07/23/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/019,121	KLOKKERS ET AL.	
	Examiner	Art Unit	
	Isis A. Ghali	1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 May 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,5-7,10-19 and 21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,5-7,10-19 and 21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The receipt is acknowledged of applicants' amendment after final filed 03/30/2009,and request for RCE filed 05/13/2009.

Claims 2, 4, 8, 9 and 20 have been canceled.

Claims 1, 3, 5-7,10-19, 21 are pending and are included in the prosecution.

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/13/2009 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 3, 5-7,10-19, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of US 6,303,141 ('141), EP 349 430 ('430) and Roark et al. "Synthesis and biological activity of Modified Peptide Inhibitors of Angiotesisn Converting Enzymes".

US '141 teaches transdermal drug delivery device comprising backing layer, matrix containing 10% ACE inhibitor and Eutanol G as permeation enhancer, and protective release liner. The ACE inhibitor is at least one of ramipril or trandolapril in the acid form or active salts which encompass monosalts. The ACE inhibitor is present in the form of prodrug or active form, i.e. dicarboxylic acid, salts and esters (abstract; col.2, lines 25-30, 37-43; the claims).

Although US '141 teaches active salts and acid of ACE inhibitors, it does not specifically teach monosalts as claimed by claim 1. US '141 does not teach the cover over the backing layer that is larger than the backing as claimed by claims 14-17.

The cover sheet and its size do not impart patentability to the claims, absent evidence to the contrary.

EP '430 teaches a transdermal system that has improved flux through the skin achieved by using specific salt forms of the drug (page 2, lines 45-50). The transdermal system has a top layer, a layer containing ACE inhibitor, an adhesive layer and protective layer (page 3, lines 40-50). The reference also disclosed on page 3 lines 4-10 the salt forms of the drugs including methane sulphonate and dicarboxylate such as maleate.

Roark teaches dicarboxylic acid diester derivatives of ACE inhibitors as very potent antihypertensive drugs (see entire document, especially pages 1291-1292).

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to provide transdermal system for delivery of salts of ACE inhibitors as disclosed by US '141, and replace the salt of ACE inhibitor by dicarboxylate derivatives of ACE inhibitor taught by EP '430. One would have been motivated to do so because EP '430 teaches that transdermal system that having dicarboxylate derivative of ACE inhibitors showed improved flux through the skin. One would reasonably expected formulating transdermal system for delivery of monosalts of ACE inhibitors at improved flux rates. Additionally, one having ordinary skill in the art would have been motivated to replace the dicarboxylate derivative of ACE inhibitor taught by Roark with

the diester derivative of dicarboxylic acid form of ACE inhibitor. One would have been motivated to do so because Roark teaches that diester derivatives of dicarboxylic acid form of ACE inhibitor is very potent antihypertensive drug. One would reasonably expected formulating transdermal system for delivery of diester derivative of dicarboxylic acid form of ACE inhibitors that treat hypertension effectively.

Response to Arguments

5. Applicant's arguments with respect to claims 1, 3, 5-7, 13-19, 21 have been considered but are moot in view of the new ground(s) of rejection.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to whose telephone number is (571) 272-0595. The examiner can normally be reached on Monday-Thursday, 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on (571) 272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

IG

/Isis A Ghali/
Primary Examiner, Art Unit 1611